

REMARKS

Reconsideration and allowance of the present application are respectfully requested in view of the foregoing amendments and the following remarks.

Claim 15 has been canceled without prejudice or disclaimer. Claims 1, 3, 7, 18 and 25 have been amended to more clearly define Applicants' invention. Claim 16 has been amended to correct an informality as explained below. Claims 32-34 have been added. Support for claims 32-34 may be found in the specification at, for example, paragraphs [0057] – [0059] and FIG. 13B. No new matter has been added. Upon entry of this Amendment, claims 1-7, 9-14, 16-18, and 20-34 are pending in the application.

In the Office Action, the specification was objected to for an inconsistency between paragraph [0050] and Figures 6 and 7. Paragraph [0050] and Figure 6 have been amended to overcome this objection. No new matter has been added. Accordingly, Applicants respectfully request that the objection be withdrawn.

The Office Action Summary indicates that the drawings filed on "February 24, 2001" are objected to by the Examiner. As no drawings were filed on February 24, 2001 it is assumed that the objection relates to the informality of the corrections filed February 24, 2003, and certain reference numerals in Figs. 12 and 13. A complete set of formal drawings is being submitted herewith.

In the Office Action, claims 1, 3, 7, 10, 11, 16, 18, 20-23, and 27 were objected to for certain informalities. Specifically, claims 1, 3, 7, 10, 11, 18, and 20-23 were objected to for reciting "a pair of rear fenders." Applicants respectfully submit that Applicants' use of "a pair of fenders" is proper because one of ordinary skill in the art understands that if fenders are provided to a vehicle, each wheel will have its own fender, regardless of how the fenders are attached to the vehicle or associated to each other. Thus, for a vehicle with a pair of rear wheels, there will be a pair of rear fenders to act as "guards over the wheels." (See Office Action at pg. 35 for the Examiner's definition of "fender"). The Office Action states that a "pair" can refer to "associated things". The definition offered in the Office Action does not require that the pair be separate, despite the leap made to "separate" in the Office Action. Many known "pairs" are connected. The mere fact that the fenders in accordance with this invention are connected (in this case by connecting wall 502) should not prevent a recitation of "a pair." One of ordinary skill in the art of vehicle design would readily understand that this vehicle has a pair of fenders. Therefore, Applicants respectfully submit that the claims,

as written, are proper and would be clear to one of ordinary skill in the art, and respectfully request that the objection be withdrawn.

Claim 16 was objected to for reciting "...wherein an end of the air intake pipe extends within the seat". Claim 16 has been amended to recite "...wherein an end of the air intake pipe is located within the seat", as suggested by the Examiner. Accordingly, Applicants respectfully request that the objection to claim 16 be withdrawn.

Claim 27 was objected to for reciting "wherein the intake pipe includes a clip that attaches to the fender structure". Applicants respectfully draw the Examiner's attention to paragraph [0051] of the specification, which states in part "Figure 8 also illustrates one preferred arrangement for connecting the air intake system 300 to a connecting wall 502 that is positioned between and *preferably formed integrally with the fender structure*, e.g., rear fenders 516 (Figure 12)." (Specification at [0051], emphasis added). The fender structure recited in the claim is not limited to the rear fenders. The specification states that the fender structure includes the rear fenders 576, not that the fender structure is limited to rear fenders 576. The specification is clear that connecting wall 502 is integral with the fenders 516. Thus, the connecting wall 502 and the fenders 576 are part of the fender structure. Applicants respectfully submit that the intake pipe includes a clip that attaches to the fender structure, as claimed, is clear in view of the description and respectfully request that the objection to claim 27 be withdrawn.

In the Office Action, claim 15 was rejected under 35 U.S.C. §112, second paragraph, for failing to set forth the subject matter which applicants regard as their invention. Claim 15 has been canceled, thereby mooted this rejection, and rewritten with claim 7 as new claim 32, discussed below.

In the Office Action, claims 7, 9, 10, 13, 14, 16, and 17 were rejected under 35 U.S.C. §102(b) as being anticipated by Japanese Patent 61-171610 ("JP '610"). Applicants respectfully traverse this rejection.

Claim 7 recites a combination of elements for a straddle-type vehicle that includes, for example, at least one opening adjacent a rear portion of the seat and supplying intake air to the air intake system. JP '610 does not disclose a combination of elements that includes, for example, at least one opening adjacent a rear portion of the seat and supplying intake air to the air intake system. In contrast, JP '610 discloses a suction port 22 located on a front fender 4. (JP '610 English Abstract, FIGs. 1-4). Although the Examiner points to element 34 as being an air intake, there is no indication that element 34 is an air intake. Accordingly,

Applicants respectfully submit that claim 7, and claims 9, 10, 13, 14, 16, and 17 that depend therefrom, are patentable over JP '610 and respectfully request that the rejection be withdrawn.

As to claim 9, in particular, which was not addressed in the Office Action, suction port 22 is specifically recited as supplying air to forcibly cool the cylinder heads. Thus, element 34 regardless of its correct label, cannot supply air to both the air intake system and the radiator. Claim 9 is not anticipated by JP '610.

In the Office Action, claims 1 and 3-6 were rejected under 35 U.S.C. §103(a) as being unpatentable over Japanese Patent 61-200029 ("JP '029"). Applicants respectfully traverse this rejection.

Claim 1 recites a combination of elements for an all terrain vehicle having a frame and front wheels and rear wheels suspended from the frame that includes, *inter alia*, a seat, a fender structure including a pair of fenders attached to the frame on either side of the seat, the rear fenders on each side of a seat having at least one ventilation opening and an intake pipe connected to and receiving intake air from the at least one ventilation opening. JP '029 does not disclose or suggest a combination of elements that includes, for example, the rear fenders on each side of a seat having at least one ventilation opening and an intake pipe connected to and receiving intake air from the at least one ventilation opening. JP '029 discloses fenders 76a and 76b that are behind the seat and clearly separate from the partition panel 84 that separates a small chamber 26 from the engine housing room 14. (JP '029, FIG. 2). The intake pipe 86 is connected to and receives intake air from an opening in the partition panel 84 behind the seat, not from an opening in the fenders 76a, 76b, as recited by claim 1. There is no suggestion in the prior art for modifying JP '029 to result in the claimed invention. Accordingly, Applicants respectfully submit that claim 1, and claims 3-6 that depend therefrom, are patentable over JP '029 and respectfully request that the rejection be withdrawn.

In the Office Action, claims 1-4 were rejected under 35 U.S.C. §103(a) as being unpatentable over Japanese Patent 60-153418 ("JP '418") in view of Japanese Patent 5-146565 ("JP '565"). Applicants respectfully traverse this rejection.

Claim 1 recites a combination of elements for an all terrain vehicle having a frame and front wheels and rear wheels suspended from the frame that includes, for example, a seat, a fender structure including a pair of fenders attached to the frame on either side of the seat, the rear fenders having at least one ventilation opening, an air box connected to frame and an

intake pipe connected to and receiving intake air from the at least one ventilation opening. As conceded by the Examiner, JP '418 fails to teach, among other features, at least one ventilation opening on the rear fenders. (Office Action, page 10). JP '565, does not make up for the deficiencies of JP '418. JP '565 does not disclose or suggest rear fenders having at least one ventilation opening, an air box connected to the frame, and an intake pipe connected to and receiving intake air from the at least one ventilation opening, as recited by claim 1. The air intake pipe 14a of JP '418 could not be connected to the at least one ventilation opening of JP '565 because the air intake pipe 14a of JP '418 is disposed between an air cleaner 13 and the carburetor. (JP '418 English Abstract). None of these references uses an air box as claimed and none suggests providing ventilation openings in rear fenders that flank a seat. To make a proper combination and *prima facie* case of obviousness, the prior art must provide some motivation for the alleged modification. Accordingly, Applicants respectfully submit that claim 1, and claims 2-4 that depend therefrom, are patentable over JP '418 in view of JP '565 and respectfully request the rejection to be withdrawn.

In the Office Action, claims 7 and 9-14 were rejected under 35 U.S.C. §103(a) as being unpatentable over JP '418 in view of JP '565. Based on the Examiner's remarks, it appears that claims 7 and 9-14 were also rejected under 35 U.S.C. §103(a) as being unpatentable over JP '418 in view of Peter et al. (U.S. Patent No. 5,947,219). Applicants respectfully traverse these rejections.

Claim 7 recites a combination of elements for a straddle-type vehicle that includes, for example, at least one opening adjacent a rear portion of the seat and supplying intake air to the air intake system and a pair of rear fenders provided adjacent the rear portion of the seat. The at least one opening is located on the front portion of at least one of the rear fenders. Neither JP '418 nor JP '565 discloses or suggests a combination of elements that includes, for example, at least one opening adjacent a rear portion of the seat and supplying intake air to the air intake system and a pair of rear fenders provided adjacent the rear portion of the seat where the at least one opening is located on the front portion of at least one of the rear fenders. JP '418 does not disclose or suggest any openings adjacent a rear portion of the seat or on the rear fenders. JP '565 merely discloses an opening 42 below the seat on a body portion of the engine cover 37. (JP '565, English Abstract). There is no indication as to what element 43 represents in the figures. Even if element 43 is an opening, which Applicants do not concede, element 43 is not adjacent a rear portion of the seat, as recited by claim 7. (JP '565, FIGs. 1, 3, and 4).

Further, Peter et al. does not teach an aperture on the rear side of a rear fender, as asserted by the Examiner. Nowhere does Peter et al. disclose or suggest what the unlabeled features on opposite sides of “32” represent. Although the Examiner has assumed that the unlabeled features in FIG. 3 are air inlets (Office Action at pages 16-18), there is absolutely nothing in Peter et al. to support such an assumption. Even if it could be shown that the unlabelled elements are vents, there is no evidence that it would be an inlet rather than an outlet. Moreover, Peter et al. does not suggest that a ventilation opening could be positioned on the front of a rear fender. Absent Applicants’ own teaching, the prior art does not suggest the claimed invention. The Office Action suggests that the openings of the combined references would avoid a one inch height of water. However, such a height would result in a water wave created by the front of vehicle. Moreover, none of the references shown an opening above the front wheels. Finally, there is no suggestion in the prior art to make the asserted modification, absent Applicants’ own teaching. Accordingly, Applicants respectfully submit that claim 7, and claims 9-14 that depend therefrom, are patentable over JP ‘418 in view of JP ‘565 and are patentable over JP ‘418 in view of Peter et al. and respectfully request the rejection be withdrawn.

In the Office Action, claims 18, 20, 21, 23, and 24 were rejected under 35 U.S.C. §103(a) as being unpatentable over JP ‘418 in view of JP ‘565. Applicants respectfully traverse this rejection.

Claim 18 recites a combination of elements for a straddle-type motor vehicle having front and rear wheels and being capable of traversing water having a predetermined depth, including, for example, an air box, at least one opening in communication with the air box, and rear fenders at least one of which having the one opening. The opening is positioned rearward and above the front wheels so that water will avoid entering the opening when a water wave created by the front of the vehicle is encountered. The Examiner concedes that JP ‘418 fails to teach at least one opening in communication with the air box, the at least one opening being provided on the rear fenders. (Office Action, page 19). Additionally, JP ‘565 does not disclose or suggest at least one opening in communication with the air box or the at least one opening being provided on the rear fenders. JP ‘565 does not even disclose or suggest an air box. As explained above, JP ‘565 discloses that element 42 in FIG. 4 is a vent hole in the engine cover 37. (JP ‘565 English Abstract, FIG. 4). There is no indication as to what element 43 represents in the figures. Thus, even if JP ‘418 and JP ‘565 were combined, which the Applicants do not concede that there would be any motivation to combine these

references, the Examiner has not made a *prima facie* case of obviousness because the references when combined do not disclose or suggest every feature of the claim. Accordingly, Applicants respectfully submit that claim 18, and claims 20, 21, 23, and 24 that depend therefrom, are patentable over JP '418 in view of JP '565 and respectfully request that the rejection be withdrawn.

In the Office Action, claims 18 and 22 were rejected under 35 U.S.C. §103(a) as being unpatentable over Japanese Patent 61-171610 ("JP '610") in view of JP '029. Applicant respectfully traverse this rejection.

Claim 18 recites a combination of elements for a straddle-type motor vehicle having front and rear wheels and being capable of traversing water having a predetermined depth, including, for example, at least one opening in communication with the air box, and rear fenders. The at least one opening is provided on at least one of the rear fenders positioned above the front wheels. JP '610 does not disclose or suggest a combination of elements including, for example, at least one opening in communication with the air box, and rear fenders, where the at least one opening is provided on at least one of the rear fenders above the front wheels. In contrast, JP '610 discloses a suction port 22 located on a front fender 4. (JP '610 English Abstract, FIGs. 1-4). Although the Examiner points to element 34 as being an air intake, there is no indication that element 34 is an air intake. Regardless of what element 34 is identified as, element 34 is not above the front wheels. JP '029 does not make up for this deficiency. As explained above, JP '029 discloses fenders 76a and 76b that are clearly separate from the partition panel 84 that separates a small chamber 26 from the engine housing room 14. (JP '029, FIG. 2). The intake pipe 86 is connected to and receives intake air from an opening in the partition panel 84, not from an opening in the fenders 76a, 76b, as recited by claim 18. Further, there is simply no motivation presented for modifying JP '610 with JP '029's teaching. There must be some suggestion in the prior art for making the asserted combination. Even if such a combination could be made and even if a proper suggestion was in the prior art, the proposed combination would not result in the features as specifically recited in claim 18. Accordingly, Applicants submit that claim 18, and claim 22 that depends therefrom, are patentable over JP '610 in view of JP '029 and respectfully request that the rejection be withdrawn.

In the Office Action, claims 25 and 27 were rejected under 35 U.S.C. §103(a) as being unpatentable over JP '029. Applicants respectfully traverse this rejection.

Claim 25 recites a combination of elements for an all terrain vehicle having front and rear wheels that includes, for example, a fender structure including at least one aperture higher than the rear wheels. JP '029 does not disclose or suggest a combination of elements that includes, for example, a fender structure including at least one aperture. JP '029 discloses fenders 76a and 76b that are clearly separate from the partition panel 84 that separates a small chamber 26 from the engine housing room 14. (JP '029, FIG. 2). What appear to be openings 88 in the rear of the small chamber are clearly not part of the rear fenders 76a, 76b, 40 and do not overlay the rear wheels 70a, 70b. (JP '029, FIG. 2). Accordingly, Applicants respectfully submit that claim 25, and claim 27 that depends therefrom, are patentable over JP '029 and respectfully request that the rejection be withdrawn.

In the Office Action, claims 25, 26, 28, 30, and 31 were rejected under 35 U.S.C. §103(a) as being unpatentable over JP '418 in view of JP '565 and Peter et al. (U.S. Patent No. 5,947,219). Applicants respectfully traverse this rejection.

Claim 25 recites a combination of elements for an all terrain vehicle having front and rear wheels that includes, for example, a fender structure including at least one aperture overlying and higher than the rear wheels, and an air intake system that includes an air intake box and an air intake pipe, the intake pipe being fastened with respect to the fender structure such that the inlet end is in communication with the aperture in the fender structure. JP '418 does not disclose or suggest a combination of elements that includes, for example, a fender structure including at least one aperture, and an air intake system that includes an air intake box and an air intake pipe, the intake pipe being fastened with respect to the fender structure such that the inlet end is in communication with the aperture in the fender structure and is positioned higher than the rear wheels. Specifically, JP '418 does not disclose or suggest, at least, a fender structure including at least one aperture or an intake pipe being fastened with respect to the fender structure such that the inlet end is in communication with the aperture in the fender structure, as recited by claim 25.

JP '565 does not make up for the deficiencies of JP '418. Specifically, JP '565 does not disclose or suggest a fender structure including at least one aperture, and an air intake system that includes an air intake box and an air intake pipe, the intake pipe being fastened with respect to the fender structure such that the inlet end is in communication with the aperture in the fender structure and is positioned higher than the rear wheels. Although JP '565 discloses an opening 42, the opening 42 is not positioned higher than the single rear

wheel. It is not clear what element 43 in the figures represents. Even if element 43 was an aperture, which Applicants do not concede, JP '565 does not disclose an air intake pipe being fastened with respect to the fender structure such that the inlet end is in communication with the aperture in the fender structure. Element 43 is also not overlying and higher than the rear wheel.

Peter et al. does not make up for the deficiencies of JP '418 and JP '565. As explained above, Peter et al. does not teach of an aperture connected to an air intake pipe on the rear fender, as asserted by the Examiner. Nowhere does Peter et al. disclose or suggest what the unlabeled features on opposite sides of "32" represent. Although the Examiner has assumed that the unlabeled features in FIG. 3 are air inlets (Office Action at pages 16-18), there is absolutely nothing in Peter et al. to support such an assumption. Further, there is simply no disclosure relating to what these unlabelled elements are connected to. Finally, there is no suggestion in the prior art to combine this assortment of references, and especially to result to in the claimed invention. Accordingly, Applicants submit that claim 25, and claims 26, 28, 30, and 31 that depend therefrom, are patentable over JP '418 in view of JP '565 and Peter et al. and respectfully request that the rejection be withdrawn.

In the Office Action, claim 27 was rejected under 35 U.S.C. §103(a) as being unpatentable over JP '418, JP '565 and Peter et al. as applied to claim 25, and further in view of Powell (U.S. Patent No. 6,243,928). Applicants respectfully traverse this rejection.

Claim 27 depends from claim 25. As explained above, Applicants respectfully submit that claim 25 is patentable over JP '418 in view of JP '565 and Peter et al. Because claim 27 depends from claim 25, claim 27 is also patentable over JP '418 in view of JP '565 and Peter et al. Powell does not make up for the deficiencies of JP '418, JP '565, and Peter et al. Powell is specifically directed to a cable and pipe clip. (Powell at Abstract). Nowhere does Powell disclose or suggest a fender structure including at least one aperture, and an air intake system that includes an air intake box and an air intake pipe, the intake pipe being fastened with respect to the fender structure such that the inlet end is in communication with the aperture in the fender structure and is positioned higher than the rear wheels (of an all-terrain vehicle). Accordingly, Applicants submit that claim 27 is patentable over JP '418, JP '565 and Peter et al. as applied to claim 25, and further in view of Powell and respectfully request that the rejection be withdrawn.

In the Office Action, claim 29 was rejected under 35 U.S.C. §103(a) as being unpatentable over JP '418, JP '565 and Peter et al. as applied to claim 25, and further in view of Japanese Patent 1301484 ("JP '484"). Applicants respectfully traverse this rejection.

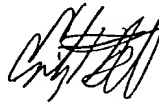
Claim 29 depends from claim 25. As explained above, Applicants respectfully submit that claim 25 is patentable over JP '418 in view of JP '565 and Peter et al. Because claim 29 depends from claim 25, claim 29 is also patentable over JP '418 in view of JP '565 and Peter et al. JP '484 does not make-up for the deficiencies of JP '418, JP '565 and Peter et al. Specifically, JP '484 does not disclose or suggest a fender structure including at least one aperture, and an air intake system that includes an air intake box and an air intake pipe, the intake pipe being fastened with respect to the fender structure such that the inlet end is in communication with the aperture in the fender structure. JP '484 discloses an air introduction port 11 connected to an air box 7 and an opening 12 at the trailing end of the air box 7. There is no indication that the opening 12 is an inlet. Regardless, JP '484 does not disclose an aperture in the fender structure. Thus, even if JP '484 was combined with JP '418, JP '565, and Peter et al., which the Applicants do not concede that there would be any motivation to combine these references, the Examiner has not made a *prima facie* case of obviousness because at least one of the features is not disclosed or suggested by any of these references. Accordingly, the Applicants submit that claim 29 is patentable over JP '418, JP '565 and Peter et al. as applied to claim 25, and further in view of Japanese Patent 1301484 ("JP '484") and respectfully request that the rejection be withdrawn.

Applicants appreciate the Examiner's indication that claim 15 would be allowable if rewritten to overcome the rejection under 35 U.S.C. §112, second paragraph, and to include all of the limitations of the base claim and any intervening claims. In response, Applicants have added independent claim 32. Applicants respectfully submit that claim 32 has been written to satisfy the requirements of 35 U.S.C. §112, second paragraph and to include all of the limitations of the base claim and any intervening claims. Specifically, claim 15 was combined with original claim 7 to clarify the invention. Accordingly, Applicants submit that claim 32, and claims 33 and 34 that depend therefrom, are patentable.

All rejections and objections having been addressed, it is respectfully submitted that the present application is in a condition for allowance and a Notice to that effect is earnestly solicited. If any point remains at issue which the Examiner feels may best be resolved through a personal or telephone interview, please contact the undersigned at the telephone number listed below.

Please charge any fees associated with the submission of this paper to Deposit Account Number 033975. The Commissioner for Patents is also authorized to credit any over payments to the above-referenced Deposit Account.

Respectfully submitted,
PILLSBURY WINTHROP LLP



EMILY T. BELL
Reg. No. 47,418
Tel. No. (703) 905-2261
Fax No. (703) 905-2500

Date: October 6, 2003
P.O. Box 10500
McLean, VA 22102
(703) 905-2000